

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed November 24, 2008. At the time of the Office Action, Claims 1-27, 29, 31 and 33-63 were pending in this Application. Claims 24-27, 29, 31 and 33-63 were previously withdrawn due to an election/restriction requirement. Claims 1-23 were rejected. Claims 1 and 13 have been amended to further define various features of Applicants' invention. Applicants respectfully request reconsideration and favorable action in this case.

Rejections under 35 U.S.C. §102

Claim 1 was rejected by the Examiner under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,148,232 issued to Avrahami ("Avrahami"). Applicants respectfully traverse and submit the cited art does not teach all of the elements of the claimed embodiment of the invention.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, "the identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co. Ltd.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Applicant respectfully submits that the art cited as anticipatory by the Examiner cannot anticipate the rejected Claims, because the cited art does not show all the elements of the present Claims.

Claim 1 has been amended to recite applying sufficient high frequency voltage to the active electrode to volumetrically remove a substantially continuous layer of the stratum corneum adjacent to or near the target site in order to improve the surface appearance of the patient's outer skin without removing the entire epidermis layer. Avrahami describes a device that creates individual, interrupted and distinct channels in the stratum corneum in order to gain access to the layers below for drug delivery for example. Therefore Avrahami does not disclose each and every element of claim 1 as amended and cannot anticipate amended claim 1. For at least these reasons, Applicants respectfully submit that amended claim 1 is in condition for allowance, and request withdrawal of the rejection.

Rejections under 35 U.S.C. §103

Claims 2-12 and 13-23 were rejected under 35 U.S.C. §103(a) as being unpatentable over Avrahami. Applicants respectfully traverse and submit the cited art combinations, even if proper, which Applicants do not concede, does not render the claimed embodiment of the invention obvious.

When determining whether a claim is obvious, the Examiner must make “a searching comparison of the claimed invention – *including all its limitations* – with the teaching of the prior art.” *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (emphasis added). All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Further, it is well settled that obviousness requires at least a suggestion of all the features in a claim. *CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) (*citing In re Royka*, 490 F.2d 981, 985 (CCPA 1974)). Moreover, as the Supreme Court recently stated, “*there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.*” *KSR Int’l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (emphasis added)).

Claim 1 has been amended to recite applying sufficient high frequency voltage to the active electrode to volumetrically remove a substantially continuous layer of the stratum corneum adjacent to or near the target site in order to improve the surface appearance of the patient’s outer skin without removing the entire epidermis layer. Avrahami describes a device that creates individual, interrupted and distinct channels in the stratum corneum in order to gain access to the layers below for drug delivery for example. Avrahami does not at least suggest all the elements of amended claim 1, and therefore cannot render obvious claim 1 as amended. For at least these reasons, Applicants respectfully submit that amended claim 1 is in condition for allowance, and request withdrawal of the rejection.

Claims 2-12 depend either directly or indirectly on claim 1. Applicants repeat and hereby incorporate the remarks made above regarding amended claim 1. For at least these reasons, Applicants respectfully submit that claims 2-12 are in condition for allowance, and request withdrawal of the rejection.

Claim 13 has been amended to include applying sufficient high frequency voltage to the active electrode to volumetrically remove a substantially continuous portion of the first outer

layer adjacent to or near said target site in order to improve the surface appearance of the patient's outer skin. Avrahami describes a device that creates individual, interrupted and distinct channels in the stratum corneum in order to gain access to the layers below for drug delivery for example. Therefore, Avrahami does not at least suggest all the elements of claim 13 as amended and cannot render obvious amended claim 13. For at least these reasons, Applicants respectfully submit that claim 13 as amended is in condition for allowance, and request withdrawal of the rejection.

Claims 14-23 depend either directly or indirectly from claim 13. Applicants repeat and hereby incorporate the remarks made above regarding amended claim 13. For at least these reasons, Applicants respectfully submit that claims 14-23 are in condition for allowance and request withdrawal of the rejection.


CONCLUSION

Applicants have made an earnest effort to place this case in condition for allowance in light of the amendments and remarks set forth above. Applicants respectfully request reconsideration of the pending claims.

Applicants believe that no fee is due with this submission; however the Commissioner is hereby authorized to charge any fees necessary or credit any overpayments to Deposit Account No. 50-0359 of ArthroCare Corporation in order to effectuate this filing.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney at 512.358.5925.

Respectfully submitted
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